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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/546,097	04/10/2000	Henrick K. Gille	08041-007001	2573

20985 7590 03/15/2002

FISH & RICHARDSON, PC  
4350 LA JOLLA VILLAGE DRIVE  
SUITE 500  
SAN DIEGO, CA 92122

EXAMINER

JOHNSON III, HENRY M

ART UNIT PAPER NUMBER

3739

DATE MAILED: 03/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/546,097

Applicant(s)

GILLE ET AL.

Examiner

Henry M Johnson, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 13-23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,8-12,24-27 and 29-31 is/are rejected.
- 7) ☒ Claim(s) 3,4 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5 & 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Claims 13-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 9.

#### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "110" and "120" have both been used to designate the distal end of the handle (page 5, Lines 16-22). Correction is required.

The drawings are objected to because:

- ✓ No # 101 on Fig. 4 as stated on page 5, line 14
- ✓ No #7 on Fig. 5A as stated on page 6, line 20
- ✓ No #7 on Fig. 6 as stated on page 7, line 6
- ✓ No # 55 on Fig. 5B as stated on page 6, line 22

Correction is required.

#### ***Specification***

The specification is objected to under 37 CFR 1.71 because it does not clearly disclose the bipolar invention. The first paragraph on page 8, details the operation for the monopolar and bipolar applications using the contact electrode to operate the electrodes at different potentials. With only a single contact electrode disclosed for supplying energy to the tip, it is not clear how bipolar operation could be achieved.

✓ The disclosure is objected to because of the following informalities: The electrode (200) is referred to as an electrode and as a conductor (page 6, line 19) in the disclosure.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC ~ 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 26 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26 recites the limitation "at least one electrode" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim.

In Claim 31, the button of the claim is indefinite as it is not clear if it is a switch to activate the electrode or performs some other function.

***Claim Rejections - 35 USC ~ 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5, 6, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,314,559 to Allen. Allen discloses an electrosurgical cutting blade having deposited thereon electrodes for contacting tissue and carrying electrical source generated hemostatic and cauterizing currents thereto, each electrode comprising an electrically conductive non-stick composite coating (Teflon® a fluoropolymer resin) deposited near the cutting edge thereof (Col. 10, lines 38-45). Teflon® also has friction reducing properties. The electrode of is comprised of metals selected from the group consisting essentially of silver, platinum, rhodium, palladium, gold, or molybdenum (Col. 10, line 65). An electrical connection may be made with the conductive material (Col. 3, line 38) which serves the function of the contact electrode of the instant application.

Claims 1, 8, 10, 11, 24, 25, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,228,800 to Degler et al. Degler et al discloses an electrosurgical instrument comprising an electrically insulated housing, constructed of a nonconductive material and having a substantially pencil shaped configuration, a blade assembly mounted in said housing and projecting from said housing, said

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blade assembly comprising a center electrode, insulation means on opposite sides of said electrode and side electrodes (Col. 7, lines 7-12). The center electrode has a beveled cutting edge and is stainless steel and the side electrodes are silver (Col. 7, line 39). The tip is essentially shaped like a lance (Figs. 3 and 5) and the electrodes are connected to the energy source (Fig. 2) via contacts (Fig. 3, #39) in the housing. A switch in the handle is provided to energize the electrode.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,314,559 to Allen in view of U.S. Patent 5,925,043 to Kumar et al. Allen is discussed above, yet does not teach the use of titanium nitride in the electrode. Kumar et al discloses an electrosurgical blade with a coating of titanium nitride (Col. 6, line 13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose titanium nitride as taught by Kumar et al in the electrode of Allen as an obvious design choice.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,228,800 to Degler et al in view of U.S. Patent 4,627,435 to Hoskin. Degler et al is discussed above, yet does not teach the use of a diamond blade. Hoskin discloses a diamond blade in a surgical knife. It would have been obvious to one having ordinary skill in the art at the time the invention was made, as it is well known in the art, to use a diamond blade as taught by Hoskin in the device of Degler et al to ensure a more durable blade.

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,228,800 to Degler et al in view of U.S. Patent 5,413,575 to Haenggi. Degler et al is discussed above, yet does not disclose the blade as being detachable. Haenggi teaches a multifunction electrocautery tool with a removable blade (Col 6, line 43). It would have been obvious to one having ordinary skill in the art

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at the time the invention was made to have the blade of Degler removable as taught by Haenggi to enable the blade to be replaced independently of the total assembly.

***Allowable Subject Matter***

Claim 28 is allowed.

Claims 3, 4, and 7 are objected to as being dependent on rejected claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 5,911,719 to Eggers discloses an electrode integral to a cutting tip for heating said tip. U.S. Patent S,125,927 to Belanger teaches a breakaway cutting edge which itself is the electrode and U.S. Patent 4,651,734 to Doss et al discloses a cutting edge with a bipolar electrode adjacent to the cutting edge.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M Johnson, III whose telephone number is (703) 305-0910. The examiner can normally be reached on Monday through Friday from 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Hmj  
March 13, 2002

  
Lee Cohen  
Primary Examiner